



#8  
Election  
6-11-01  
D-1108

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
David T. Frederick	)	
	)	Art Unit: 3651
Serial No.: 09/288,685	)	
	)	
Filed: April 9, 1999	)	Patent Examiner:
	)	Jeffrey Shapiro
For: Medical Cabinet With	)	
Adjustable Drawers	)	

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Reconsideration and withdrawal of the restriction requirement dated May 22, 2001 is respectfully requested.

**Applicants Provisionally Elect With Traverse**

In response to the Office Action ("Action") dated May 22, 2001 requiring restriction election, Applicant provisionally elects with traverse Group II (which includes at least claims 1-28 and 40-56). However, as discussed in more detail below, Applicant respectfully submits that Group II should include at least claims 1-28 and 30-56.

### **Application Record**

The following dates and papers are associated with this application:

1. 08/17/00 Office Action examination of the claims on the merits (with no restriction requirement).
2. 11/10/00 Applicant's Response.
3. 02/12/01 Office Action restriction (first) after action on the merits.
4. 03/01/01 Applicant's Response.
5. 05/22/01 Office Action restriction (second) after action on the merits.

### **Simultaneous Restriction Requirements Is Improper**

It is noted that the latest (05/22/01) restriction requirement has been imposed on Applicant without withdrawal of the previous (02/12/01) restriction requirement. This act by the Office is conflicting, confusing, and improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

In order to be in compliance with the latest (05/22/01) restriction requirement, Applicant's remarks herein are made under the presumption that the previous (02/12/01) restriction requirement has been withdrawn.

### **The Definitions Of The Groups Are Improper**

The Action indicates alleged Group I as directed to "Claims 29-39, drawn to a medical cabinet having computer control."

It is respectfully noted that claims 30-39 are directly or indirectly dependent on independent claim 41, which the Office admits is drawn to the other Group II. It follows that Group II should also include claims 30-39. Thus, claims 30-39 are improperly grouped in Group I. Therefore, the restriction requirement is based on an improper grouping of the claims. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

It is respectfully noted that only Group I claim 39 mentions a "computer." Claims 29-38 are not "drawn to a medical cabinet having computer control" (Group I definition). Thus, claims 29-38 are not properly drawn to alleged Group I. Therefore, the restriction requirement is based on an improper Group I definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

As shown herein, claims 30-39 are not properly drawn to Group I because of their dependency on Group II. Claims 29-38 are not properly drawn to Group I because they do not meet the Group I definition of being "drawn to a medical cabinet having computer control." Hence, it follows that none of the claims 29-39 are properly drawn to alleged Group I. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

#### **Groups I And II Are Not Distinct**

The Action alleges that Groups I and II are related as combination and subcombination. The Action states that the combination (I) does not require the particulars of the subcombination (II) because "the particulars of the cabinet with a computer control is not required for patentability of the apparatus or methods of use." The Action also states that the subcombination

(II) has separate utility "such as for integrating medical distribution within a real-time scheduling system."

Applicants disagree. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The Patent Office must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations. When these factors are not shown, then the alleged inventions are not distinct. Applicant respectfully submits that the Office does not meet these burdens. It follows that the alleged Groups are not distinct.

The Office must show that the combination as claimed does not require the particulars of the subcombination. The Office has it backwards. The Office attempts to show that the subcombination as claimed does not require the particulars of the combination. For example, the Action states that "the particulars of the cabinet with a computer control" (alleged combination Group I) is not required for patentability of the apparatus or methods of use (alleged subcombination Group II). Thus, the Office has not shown that the alleged combination (I) as claimed does not require the particulars of the alleged subcombination (II). Thus, the alleged Groups are not distinct. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, it is unclear as to what claim language prevents the alleged combination (I) from having utility "such as for integrating medical distribution within a real-time scheduling system." That is, the Office Action has not shown how the alleged subcombination (II) has some "separate" utility apart from the alleged combination (I). Therefore, the allegation that the

alleged subcombination (II) has “separate” utility is improper. Thus, the alleged Groups are not distinct. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

### **Reasons For Insisting On Restriction Have Not Been Provided**

In making a restriction requirement, it is understood that the initial burden is on the Office to establish a *prima facie* case that: (a) the claimed inventions are independent or distinct and (b) there would be a serious (or undue) burden on the examiner if restriction is not required (MPEP § 803).

Furthermore, MPEP § 808 indicates that with regard to every requirement to restrict the Office has the burden of showing two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween.

As shown herein by Applicant, these burdens have not been met. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

### **The Restriction Requirement Is Without Legal Basis**

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being “distinct.” The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C.

§ 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both “independent” and “distinct.” The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

Furthermore the Patent Office has acknowledged that before claimed inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. All the claims directed to Applicants’ invention are related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.

### **Conclusion**

The restriction requirement is respectfully traversed. None of the alleged Groups are distinct from any of the other alleged Groups. Therefore, it is respectfully requested that the restriction requirement be withdrawn.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



Ralph E. Jocke      Reg. No. 31,029

WALKER & JOCKE

231 South Broadway

Medina, Ohio 44256

(330) 721-0000



06-05-01

3651

# Walker & Jocke

a legal professional association

Ralph E. Jocke

Patent  
&  
Trademark Law

RECEIVED

JUN 08 2001

June 1, 2001

TO 3600 MAIL ROOM

RECEIVED

JUN 07 2001

TO 3600 MAIL ROOM

Box Non-Fee  
Commissioner for Patents  
Washington, D.C. 20231Attn: Art Unit 3651  
Patent Examiner Jeffrey Shapiro

Re: **Application Serial No.:** 09/288,685  
**Applicant:** David T. Frederick  
**Title:** Medical Cabinet With Adjustable Drawers  
**Docket No.:** D-1108

Sir:

Please find enclosed Applicant's Response to the Office Action dated May 22, 2001 for filing in the above identified Application.

Very truly yours,

Ralph E. Jocke  
Reg. No. 31,029CERTIFICATE OF MAILING BY EXPRESS MAILI hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Box Non-Fee, Commissioner for Patents, Washington, D.C. 20231 this 4th day of June/2001.

EL820016939US

Express Mail Label No.

  
Ralph E. Jocke330 • 721 • 0000  
MEDINA330 • 225 • 1669  
CLEVELAND330 • 722 • 6446  
FACSIMILErej@walkerandjocke.com  
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601